

REMARKS**I. General**

The issues outstanding in the instant application are as follows:

- The Abstract is objected to;
- Claims 4 and 5 are objected to for informalities and under 37 CFR § 1.75;
- Claims 6 and 7 are rejected under 35 U.S.C. § 112, second paragraph;
- Claims 1, and 6 stand rejected under 35 U.S.C. 102(b) as anticipated by Hubbard, U.S. Pat. No. 1,502,431 (hereinafter *Hubbard*);
- Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Hubbard* in view of Ross, U.S. Pat. No. 4,821,025 (hereinafter *Ross*); and
- Claims 7-12 stands rejected under 35 U.S.C. § 103(a) as unpatentable over *Hubbard*.

Applicant hereby traverses the outstanding claim rejections, and requests reconsideration and withdrawal of the outstanding rejections in light of the amendments and remarks contained herein. Claims 1 through 3 and 5 through 12 remain pending in this application, following amendment.

II. Objection to the Specification

The Office Action objects to the use of the phrase: "The present invention is directed to" in the Abstract. Above, Applicant has amended the Abstract to remove the objectionable phrase. Therefore, Applicant respectfully requests that the objection to the Abstract be withdrawn as moot.

III. Claim Objections

Claims 4 and 5 are objected to for informalities. The Office Action has objected to various language of claim 4, and claim 4 has been objected to under 37 CFR § 1.75 as failing

to further limit the subject matter of parent claim 1. In light of the cancellation of claim 4 above, these objections are now moot.

Claim 5 is also objected to under 37 CFR § 1.75 as failing to further limit the subject matter of parent claim 1. Applicant, respectfully points out that claim 5, as originally filed, recited the element “said first mount bracket and said second mount bracket to rotate together about said rotation axis,” which further limits claim 1. However, in the interest of clarity Applicant has removed the arguably repetitive elements of claim 5 above. Therefore, Applicant respectfully requests that the objection to claim 5 be withdrawn.

Although claim 12 was not objected to by the Office Action, claim 12 has been amended above to more closely conform the language of the claim with the language of its parent claim, claim 8.

IV. Rejections under 35 U.S.C. § 112, second paragraph

Claims 6 and 7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action objects to claim 6, alleging its lack of punctuation makes the claim unclear. In response, Applicant has amended claim 6, to reposition the word “apart.” Applicant respectfully submits that this amendment clarifies the intended recitation of elements in claim 6, so as to make it more clear what is claimed, without the need to add punctuation.

Claim 7 has been objected to as lacking proper antecedent basis for the element “said fastening system.” In response Applicant has amended claim 7 to correct this clerical error by replacing the element “said fastening system” with the element “at least said first mount bracket.” Clear antecedent basis for the element “at least said first mount bracket” can be found in claim 1, which recites “a first mount bracket.”

As a result of the amendments to claims 6 and 7, Applicant respectfully requests that the rejections of claims 6 and 7 under 35 U.S.C. § 112, second paragraph, be withdrawn.

V. Rejection under 35 U.S.C. §102(b)

Claims 1 and 6 stand rejected under 35 U.S.C. 102(b) as anticipated by *Hubbard*. Applicant respectfully traverses this rejection.

The recited reference does not teach all claimed limitations.

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” see M.P.E.P. § 2131, citing *In re Bond*, 15 US.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejection does not satisfy these requirements.

Independent claim 1, in part, recites “a first mount bracket rotatably attached to a first assembly” and “a second mount bracket rotatably attached to a second assembly”. *Hubbard* does not disclose at least these limitations, particularly the claimed arrangement. As best illustrated in FIGURES 3 and 4 of *Hubbard*, and discussed beginning at line 66 of column 2, portion 9 is an integral rigid part of plate 8, which is in turn rigidly secured to a car door edge by fasteners 8^a. Thus, *Hubbard* does not teach the claimed rotatably attaching a first bracket to a first assembly and rotatably attaching a second mount bracket to a second assembly. At least one of the “brackets” of *Hubbard* is not rotatably mounted to its respective assembly.

In part, claim 1 also recites “...said mount brackets retain rotational freedom around a rotation axis.” *Hubbard* does not disclose at least this limitation. It is apparent that *Hubbard* fails to teach a single axis about which both of plates 9 and 10 rotate, together. As clearly shown in FIGURES 3 and 4 of *Hubbard*, and discussed in column 2, at line 62 and at line 78, pintle 7 does not establish an axis of rotation about which plates 9 and 10 rotate together.

Therefore, Applicant respectfully asserts that at least for the above reasons independent claim 1 is patentable over the 35 U.S.C. § 102 rejection of record. Furthermore, there are great differences between claim 1 and the prior art of record, and a person of ordinary skill in the art considering the prior art would not find these differences obvious.

Claim 6 depends directly from base independent claim 1, and thus inherits all limitations of claim 1. Thus, for at least the reasons advanced above in addressing the

anticipation rejection of claim 1, Applicant respectfully asserts that claim 6 sets forth features and limitations not recited by *Hubbard*.

VI. Rejections under 35 U.S.C. §103(a)

Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Hubbard* in view of *Ross*. Claims 7-12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Hubbard*. Applicant respectfully traverses these rejections.

A Prima Facie case of obviousness has not been established.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criterion, Applicant asserts that the rejection does not satisfy the first and third criteria.

A. The recited combination does not teach or suggest all claimed limitations.

With respect to claims 2 and 3, the Office Action admits that *Hubbard* does not teach “said first mount bracket is attached to said first assembly with an assembly screw and an insert”. The Office Action attempts to cure this deficiency by introducing *Ross*, which the Office Action alleges to teach having such a screw and insert. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Moreover, claim 2’s base independent claim, claim 1, is defined as described above. *Hubbard* does not disclose various elements of claim 1, as discussed above. *Ross* is not relied upon in the Office Action as disclosing these various elements, nor does *Ross* teach or suggest these elements. Therefore, the combination of references does not teach all elements of the claimed invention.

Furthermore, *Ross* fails to disclose other limitations of claim 2. Claim 2, in part, recites “wherein said first mount bracket is attached to said first assembly with an assembly

screw and an insert” (emphasis added). As discussed in paragraphs 21 and 22 of the present specification:

“Threaded inserts 601 and 602 are configured to be pressed into material such as a sheet metal piece...the outside portion of the threaded inserts have a round cylinder portion and a mounting feature on the bottom that, using a hydraulic press, is pressed into the sheet metal. Threaded inserts 601 and 602 extend out from rotating mounting brackets 301 and 303 such that they extend into and through a clearance hole in device bracket 102 and floor piece 103, respectively, and provide a bearing mechanism. Effectively, the threaded inserts enable rotating bracket assembly 104 to rotate back and forth without loosening assembly screws 305 and 501.”

Contrary to the Office Action’s contention, *Ross* fails to disclose an insert. As clearly shown in FIGURES 1 and 3, and discussed at column 4, line 31, item 38 of *Ross* is an external conventional nut, which can in no way be said to be fitted into anything, but rather bears on a surface of plate 26. Thus, *Ross* does not teach the claimed insert.

Claim 3 depends directly from base claim 2, and thus inherits all limitations of claim 2. Resultantly, claim 3 sets forth features and limitations, such as an insert, not recited by the combination of *Hubbard* and *Ross*. Furthermore, item 34 of *Ross* is clearly described, at least in column 4, line 28, as a bolt, not a machine screw, as recited in claim 3. Thus, Applicant respectfully asserts that at least for the above reasons claims 2 and 3 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 7-12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Hubbard*. With respect to claim 7, Applicant respectfully points out that claim 7’s base independent claim, claim 1, is defined as described above. *Hubbard* does not disclose various elements of claim 1, as discussed above. *Ross* is not relied upon in the Office Action as disclosing these various elements, nor does *Ross* teach or suggest these elements. Therefore, *Hubbard*, as modified by the Office action does not teach all elements of the claimed invention.

Further, with respect to claim 7, the Office Action admits that *Hubbard* does not teach “manually grasping and positioning the fastening system using one ear of the first mount bracket.” To address this deficiency the Office Action goes on to state: “first mount bracket 12 includes ear 10a. Therefore, it would have been obvious that the fastening system of *Hubbard* could be manually grasped and positioned using ear 10a.” Applicant respectfully traverses this conclusion. Claim 7, as amended, recites “manually grasping and positioning at

least said first mount bracket using at least one ear of said first mount bracket.” Applicant respectfully points out that *Hubbard* describes extension portions 10^a as permitting “easy sliding of the portion 10 on the integral portion 9 of leaf 8” (column 2, lines 82-85). However, nothing in *Hubbard* teaches or suggests “manually grasping and positioning at least said first mount bracket”, using the extension portions 10^a. Therefore, Applicant respectfully submits that for at least the foregoing reasons, claim 7 is patentable over the obviousness rejection of record.

Additionally, since *Hubbard* does not teach grasping of extension portion 10^a, Applicant believes that the Examiner has either relied on his own personal knowledge, or taken Official Notice, with respect to this matter. Under Rule 37 C.F.R. § 1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertion. Alternatively, under M.P.E.P. § 2144.03, the Examiner is hereby requested to cite a reference in support of the assertion. Otherwise the rejection of claim 7 should be withdrawn.

In addressing claims 8-12, the Office Action admits that “Hubbard does not disclose the perpendicular arms being rigidly attached in at least two positions.” The Office Action attempts to address this deficiency by introducing skill in the art, which the Office Action alleges to teach “rigidly attaching the perpendicular arms in at least two positions” and providing “an appropriate number of attachments in the perpendicular arms to achieve an effective attachment.” Applicant believes that the Examiner has either relied on his own personal knowledge, or taken Official Notice, with respect to this matter. Under Rule 37 C.F.R. § 1.104(d)(2), the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for the assertion. Alternatively, under M.P.E.P. § 2144.03, the Examiner is hereby requested to cite a reference in support of the assertion. Otherwise the rejection of claims 8-12 should be withdrawn.

Also, as noted above in addressing the anticipation rejection of claim 1, *Hubbard*, contrary to the contentions of the Office Action, fails to teach or suggest “rotatably attaching a first mount bracket to a first assembly” or “rotatably attaching a second mount bracket to a second assembly” as also recited in independent claim 8.

Therefore, for at least this reason Applicant respectfully contends that independent claim 8 is patentable over the § 103 rejection of record. Claims 9 through 12 ultimately depend from claim 8, and thus each of claims 9 through 12 inherit all limitations of claim 8. Thus, for at least the reasons advanced above in addressing the rejection of claim 8, each of claims 9-12 sets forth features and limitations not recited by *Hubbard* as modified by the Office Action. Further, as pointed out above, in addressing the rejection of claim 3, *Hubbard* fails to disclose use of a machine screw, as recited in claim 10. Therefore, Applicant respectfully asserts that for at least the above reasons claims 9 through 12 are also patentable over the 35 U.S.C. § 103(a) rejection of record.

B. The Office Action does not provide the requisite motivation.

As noted above, the Office Action admits, with respect to claims 2 and 3, *Hubbard* does not teach “the first mount bracket being attached to the first assembly by mating an assembly screw with an insert.” The Office Action attempts to cure this deficiency by introducing *Ross*, which the Office Action alleges to teach such a screw and insert. The motivation for making the combination was presented as follows:

it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have attached the first mount bracket of *Hubbard* to the first assembly using an assembly screw and an insert, in light of the teachings of *Ross*, Sr., in order to provide a pivotal connection.

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. Language such as “in order to provide a pivotal connection” is tantamount to a mere statement that the reference can be modified, and as such does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Office Action is improper, as the motivation must establish the desirability for making the modification. No valid suggestion has been made as to why a combination of *Hubbard* and *Ross* is desirable. Therefore, the rejection of claims 2 and 3 should be withdrawn.

Furthermore, Applicant respectfully asserts that the Office Action is relying on impermissible hindsight in order to piece together the elements of claims 2 and 3 based on knowledge gleaned from Applicant's disclosure. Applicant asserts that without the teachings of Applicant's disclosure one of ordinary skill in the art would not find it obvious to use an insert as recited by claim 2, particularly as *Ross* teaches away from the use of an insert as recited by claim 2. As noted above, *Ross* expressly teaches the use of a nut rather than an internal insert. Further, the connection provided by the bolt and nut of *Ross* is not a pivotal connection. Thus, Applicant respectfully contends that the stated motivation depends so heavily on the teachings of Applicant's disclosure that it is quite clear that the Office Action is relying on impermissible hindsight in order to piece together the elements of the claims. Accordingly, Applicant fails to understand how one of ordinary skill in the art would be motivated to combine the teachings of *Hubbard* and *Ross* "to provide a pivotal connection," absent application of the teachings of the present disclosure. For at least the foregoing reasons the rejection of claims 2 and 3 should be withdrawn.

With respect to claim 7, the Office Action admits that *Hubbard* fails to teach "manually grasping and positioning the fastening system using one ear of the first mount bracket." To address this deficiency the Office action states:

However first mount bracket 12 includes ear 10a. Therefore it would have been obvious that the fastening system of *Hubbard* could be manually grasped and positioned using ear 10a.

Applicant respectfully asserts that this is also a mere statement that the reference can be modified and that this statement clearly fails to indicate any desirability for making the modification. Therefore, the rejection of claim 7 should also be withdrawn.

Turning to the rejection of claims 8-12, the Office Action admits that *Hubbard* does not teach "the perpendicular arms being rigidly attached in at least two positions." The Office Action attempts to cure this deficiency by introducing skill in the art. The motivation for making the modification was presented as follows:

it would have been obvious to one of ordinary skill in the art at the time the invention was made that rigidly attaching the perpendicular arms in at least two positions is an obvious matter of design choice wherein no state problem is solved or unexpected results obtained in attaching the perpendicular arms in at least two positions versus attaching them in one position as taught by Hubbard as long as an effective attachment is achieved. Furthermore it is within the general knowledge of one of ordinary skill in the art to provide an appropriate number of attachments in the perpendicular arms to achieve an effective attachment.

As discussed above, the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. Language such as “as long as an effective attachment is achieved” and “to achieve an effective attachment” is tantamount to a mere statement that the reference can be modified, and does not state any desirability for making the modification. As also noted above, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Thus, the motivation provided by the Office Action is improper, as the motivation must establish the desirability for making the modification. No valid suggestion has been made as to why a combination of *Hubbard* and common knowledge is desirable. Therefore, the rejection of claims 8-12 should also be withdrawn.

VII. Conclusion

For all the reasons given above, Applicant submits that the pending claims distinguish over the prior art of record under 35 U.S.C. §§ 102 and 103, and meet the requirements of 35 U.S.C. § 112. Applicant respectfully submits that this application is in full condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue.


Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10017979-4 from which the undersigned is authorized to draw.

Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that the attorney can be helpful in resolving any remaining issues or can otherwise be helpful in expediting prosecution of the present application.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV482740188US in an envelope addressed to: MS Amendment, Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: March 1, 2005

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